

REMARKS UNDER 37 CFR § 1.111

Formal Matters

Claims 13-38 and 40-54 are pending after entry of the amendments set forth herein.

Claims 13-39 were examined. Claims 13-39 were rejected.

Applicants respectfully request reconsideration of the application in view of the amendments and remarks made herein.

No new matter has been added.

The Office Action

Claims Rejected on Ground of Nonstatutory Obviousness Type Double Patenting – U.S. Patent No. 6,199,556 in view of Deckman et al.

In the Official Action of July 26, 2007, claims 13, 24-28, 31-34 and 36-39 were rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 8-20 of U.S. Patent No. 6,199,556 in view of Deckman et al., U.S. Patent No. 5,984,867. Without acquiescing to this ground of rejection, since Applicants do not believe that it is proper, but in order to advance the prosecution of the present application, Applicants are submitting herewith a terminal disclaimer with regard to U.S. Patent No. 6,199,556.

Accordingly, the Examiner is respectfully requested to reconsider and withdraw the rejection of claims 13, 24-28, 31-34 and 36-39 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 8-20 of U.S. Patent No. 6,199,556 in view of Deckman et al., U.S. Patent No. 5,984,867, as being moot.

Claims Rejected on Ground of Nonstatutory Obviousness Type Double Patenting – U.S. Patent No. 6,736,774 in view of Deckman et al.

Claims 13, 24-28, 31-34 and 36-39 were rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 6,736,774 in view of

Deckman et al., U.S. Patent No. 5,984,867. Without acquiescing to this ground of rejection, since Applicants do not believe that it is proper, but in order to advance the prosecution of the present application, Applicants are submitting herewith a terminal disclaimer with regard to U.S. Patent No. 6,736,774.

Accordingly, the Examiner is respectfully requested to reconsider and withdraw the rejection of claims 13, 24-28, 31-34 and 36-39 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 6,736,744 in view of Deckman et al., U.S. Patent No. 5,984,867, as being moot.

Claims Rejected Under 35 U.S.C. Section 102(e) (Deckman et al.)

Claims 13-28 and 31-39 were rejected under 35 U.S.C. Section 102(e) as being anticipated by Deckman et al., U.S. Patent No. 5,984,867. The Examiner asserted that Deckman et al. disclose a main body 102 configured to rest against the frontal body of a patient and a lifting arm 110 movably mounted to the main body and adapted to engage and lift at least a portion of the ribs of the patient.

Applicants have amended claims 13, 31, 37 and 38 to further recite that the lifting arm is rotatably mounted to the main body. Support for these amendments can be found, for example, at page 11, lines 1-4, Figs. 2-7 and the description thereof in the specification. Deckman et al., on the other hand describes the column 104 (which is fixed to the foot 102) as being slidable (e.g., see column 6, lines 22-24) and Figs. 5-6 of Deckman et al. illustrate the rotationally fixed arrangement of foot 102 and beam 110, as the foot rotates or rocks together with the beam 110 due to the fixed connection therebetween.

The Examiner further broadly asserted that Deckman et al. discloses all the limitations of claims 14-28, 32-36 and 39 at column 3, lines 12-56, column 4, lines 1-67, column 5, lines 1-67, column 6, lines 1-24 and in Figs. 1-12. Applicants respectfully traverse.

The Examiner has referred to the foot 102 as meeting the recitations of the “main body” recited in claim 13. Foot 102 has only one contact point. Accordingly, it is respectfully submitted that Deckman et al. clearly fails to disclose two contact points with the lifting arm being mounted to the body at a location intermediate of the two contact points, as recited in claim 15. If the Examiner intends to maintain this position, the Examiner is respectfully requested to specifically identify where the Examiner interprets Deckman et al. to disclose the recitations of claim 15.

It is respectfully submitted that claim 16 is also not disclosed by Deckman et al., for the same

reasons noted above with regard to claim 15. If the Examiner intends to maintain this position, the Examiner is respectfully requested to specifically identify where the Examiner interprets Deckman et al. to disclose the recitations of claim 16.

With regard to claim 19, it is respectfully submitted that lifting and retraction are both driven by the same driving mechanism in Deckman et al. If the Examiner intends to maintain his position with regard to claim 19, the Examiner is respectfully requested to specifically identify where the Examiner considers Deckman et al. to disclose two different driving mechanisms, as recited in claim 19.

With regard to claim 23, the Examiner has not identified what he interprets in Deckman et al. to meet the claimed retractor arm. However, it is respectfully submitted that none of the elements mounted to foot 102 are mounted by a hinge.

With regard to claim 27, it is respectfully submitted that Deckman et al. fails to disclose an organ positioner fixed to a main body, or an organ positioner whatsoever. If the Examiner intends to maintain this position, the Examiner is respectfully requested to specifically identify where the Examiner interprets Deckman et al. to disclose an organ positioner.

Similar arguments apply to claims 28, 33 and 34.

With regard to claim 35, Applicants were unable to locate a disclosure by Deckman et al. of a light mounted to a retractor. If the Examiner intends to maintain this position, the Examiner is respectfully requested to specifically identify where the Examiner interprets Deckman et al. to disclose a light mounted to a retractor.

Applicants respectfully traverse the Examiner's assertion that "the recitation that an element is 'adapted to' or 'configured to' perform a function is not a positive limitation but requires the ability to so perform. It does not constitute a limitation in any patentable sense." In *In re Venezia*, 189 USPQ 149-152, CCPA, 1976, the court addressed the limitations "each sleeve of said pair *adapted to be fitted* over the insulation jacket of one of said cables". The court stated that "Rather than being a mere direction of activities to take place in the future, this language imparts a structural imitation to the sleeve."

In view of the above amendments and remarks, the Examiner is respectfully requested to reconsider and withdraw the rejection of claims 13-28 and 31-39 under 35 U.S.C. Section 102(e) as being anticipated by Deckman et al., U.S. Patent No. 5,984,867, as being clearly inappropriate.

Claims Rejected Under 35 U.S.C. Section 103(a) (Deckman et al. in view of Asrican)

Claims 29-30 were rejected under 35 U.S.C. Section 103(a) as being unpatentable over Deckman et al., U.S. Patent No. 5,984,867 in view of Asrican, U.S. Patent No. 3,680,546. It is respectfully submitted that Asrican fails to make up for the deficiencies of Deckman et al. in meeting all of the recitations of claim 13. Accordingly, since claims 29-30 depend from claim 13, it is respectfully submitted that claims 29-30 are allowable for at least the same reasons provided above with regard to claim 13.

Accordingly, in view of the above amendment of claim 13 and remarks, the Examiner is respectfully requested to reconsider and withdraw the rejection of claims 29-30 under 35 U.S.C. Section 103(a) as being unpatentable over Deckman et al., U.S. Patent No. 5,984,867 in view of Asrican, U.S. Patent No. 3,680,546, as being inappropriate.

New Claims

New claims 40-54 have been submitted above. Support for these claims can be found in Figs. 2-7 and the description thereof in the specification. It is respectfully submitted that new claims 40-54 are all allowable over the art of record, and an indication of the allowance of these claims is respectfully requested in the next Official Action.

Conclusion


Applicants submit that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, please telephone the undersigned at the number provided.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-2653, order number GUID-008CON2.

Respectfully submitted,

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